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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/830,111

04/23/2004

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EXAMINER

BRINICH, STEPHEN M

ART UNIT

PAPER NUMBER

2625

NOTIFICATION DATE

DELIVERY MODE

08/05/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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| | | | |
|------------------------------|---------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/830,111 | Applicant(s) RAHMAN ET AL. | |
| | Examiner STEPHEN M. BRINICH | Art Unit 2625 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,15,19,20 and 22-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 20 and 22-25 is/are allowed.
- 6) ☒ Claim(s) 1-6,8,15 and 19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments (5/7/09 Response: page 6, lines 9-24) with respect to the rejection of claim 20 & 22-24 under 35 USC §102 and the objection to claims 25-26 have been fully considered and are persuasive. Therefore, the rejection of claims 20 & 22-24 and the objection to claim 25 have been withdrawn. The objection to claim 26 has been obviated by its cancellation.

2. Applicant's arguments (5/7/09 Remarks: page 6, lines 9-24) have been fully considered but they are not persuasive.

Applicant argues that independent claim 1 is allowable because is amended to incorporate the allowable subject matter recited in claim 3.

However, for the reasons set forth below, the portion of claim 3 now incorporated into claim 1 (insofar as it is understood: see 35 USC §112 rejection below) does not patentably distinguish claim 1 over the art of record.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6, 8, 15, & 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 4, the term "the selected digital graphic element" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

6. Claims 1-2 & 15, insofar as they are understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Henry (US 6898625).

Re claim 1, Henry et al discloses (column 4, line 59 - column 7, line 18, particularly the excerpts thereof noted below; Figure 2) an image forming device and method in which an image source scans an input document to obtain image data (column 4, line 65 - column 5, line 5) and accepts user-supplied digital graphic element data (e.g. a message 210; column 5, lines 44-57; one version of message 210 is described as a string of ASCII characters, which are a form of digital data; column 6, lines 57-59). The scanned input document and user-supplied digital graphic element data are combined into a composite image

electronic document (column 5, lines 6-19; Figure 2), which is printed by an output device (column 6, lines 1-9).

Further re claim 1, Henry et al discloses (Figure 2; column 5, lines 13-15) that the user-supplied digital graphic element data (i.e. message 210; see column 5, lines 44-57) selected by the user for composition with the document are placed in the document at a position selected by the user (i.e. it may be placed in the header, or not, as the user selects).

Re claim 2, Henry et al discloses (column 5, lines 50-57) that the user-supplied digital graphic data may be either user-customized or a selection from a standard menu (which must inherently be stored in order for the menu items to be available for selection after the menu has been initially created). This user-supplied digital graphic data is then stored as part of the electronic document.

Re claim 15, Henry et al discloses (column 6, line 6) the use of a photocopier as the image forming device.

Claim Rejections - 35 USC § 103

7. Claim 19, insofar as it is understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Henry et al in view of "Xerography and Photocopying" by George Watson, University of Delaware (referenced as "Xerography and Photocopying").

Re claim 19, as noted above Henry et al describes the use of a photocopier to form an image, but does not specify that the photocopier is xerographic.

It is well known to one of ordinary skill in the art that a standard photocopier uses a xerographic process to place images on paper, as taught for example by "Xerography and Photocopying".

Henry et al and "Xerography and Photocopying" are combinable because they are from the field of document photocopying.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use xerographic technology to implement the (not further specified) "photocopier" of Henry et al.

The suggestion/motivation for doing so would have been to implement a "photocopier" function using standard off-the-shelf photocopier technology.

Therefore, it would have been obvious to combine Henry with "Xerography and Photocopying" to obtain the invention as specified in claim 19.

Allowable Subject Matter

8. Claims 20 & 22-25 are allowed.

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9. Claims 3-6 & 8, insofar as they are understood, would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Re claims 3 & 20 (and dependent claims 4-6, 8, & 22-25), insofar as they are understood, the art of record does not teach or suggest the recited selection of digital graphic element data positioning in conjunction with the recited arrangement of compositing the digital graphic element and a scanned input document in order to form a composite image.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action

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is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning the contents of this communication or earlier communications from the examiner should be directed to Stephen M. Brinich at 571-272-7430.

Any inquiry relating to the status of this application, entry of papers into this application, or other any inquiries of a general nature concerning application processing should be directed to the Tech Center 2600 Customer Service center at 571-272-2600 or to the USPTO Contact Center at 800-786-9199 or 571-272-1000.

The examiner can normally be reached on weekdays 8:00-5:30, alternate Fridays off.

If attempts to contact the examiner and the Customer Service Center are unsuccessful, supervisor Edward Coles can be contacted at 571-272-7402.

Faxes pertaining to this application should be directed to the Tech Center 2600 official fax number, which is 571-273-8300.

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Hand-carried correspondence may be delivered to the Customer Service Window, located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314.

/S. M. B./

Examiner, Art Unit 2625

/Thomas D Lee/

Primary Examiner, Art Unit 2625